

## **REMARKS**

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Initially, the undersigned would like to thank the Examiner for taking time to discuss the present application during a telephone interview on December 8, 2008. The below comments will make reference to the conversation, as an agreement was reached on a particular matter.

Claims 2 – 5 and 7 – 10 were objected to for depending upon a rejected base claim, but were otherwise indicated as containing allowable subject matter. As such, the claims would be allowable if amended into independent form so as to include all of the limitations of the base claim and any intervening claims. Claims 1 and 6, from which claims 2 and 7 depend, respectively, were amended to include the features of claims 2 and 7, respectively. Claims 2 and 7 were cancelled, and claims 3 – 5 and 8 – 10 were amended to correct their dependencies. Accordingly, claims 1, 3 – 6, and 8 – 10 are now in a condition indicated by the Examiner as allowable.

Claims 16 and 18 were objected to for informalities. The claims were amended in accordance with the Examiner's suggestions. As amended, the Examiner's grounds for objection have been removed. Withdrawal of the objection of claims 16 – 18 is requested.

Claims 11 – 12 and 16 were rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter

that applicant regards as the invention. Claims 11 and 12 were rejected for having insufficient antecedent basis for the recitation of "the autobicycle". Claim 6, from which both claims 11 and 12 depend, has been amended to introduce an autobicycle, thereby remedying any antecedent basis issues with claims 11 and 12. Withdrawal of the rejections of claims 11 and 12 is requested. As claims 11 and 12 were only rejected under this section, claims 11 and 12 are presently considered to be allowable.

Claim 16 was rejected for failing to provide sufficient antecedent basis for the recitation of "supporting the shaft". The undersigned discussed the rejection of claim 16 during the above referenced telephone interview. During the interview, the Examiner expressed agreement with the undersigned that the rejection of claim 16 under this section was improperly made. Specifically, it was noted that claim 15, from which claim 16 depends, introduces a shaft, and claim 16 references "a shaft supporting structure rotatably supporting the shaft". As such, the shaft of claim 16 has been properly introduced. Accordingly, there is sufficient antecedent basis for the recitation, and the rejection of claim 16 under this section was improperly made. Withdrawal of the rejection of claim 16 is requested.

Claims 1 and 6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,578,046 to Ohno (hereinafter, "Ohno"). The rejections are traversed for the following reasons.

As mentioned above, claim 1 was amended to incorporate the features of claim 2, which was indicated by the Examiner as containing allowable subject matter. Similarly, claim 6 was amended to incorporate the features of claim 7, which was also indicated by the Examiner as containing allowable subject matter.

Accordingly, as amended, claims 1 and 6 are in a condition indicated by the Examiner as allowable. Withdrawal of the rejections of claims 1 and 6 is requested.

Claims 13 – 17 were rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,514,119 to Lee et al. (hereinafter, "Lee"). The rejections are traversed for the following reasons.

Claim 13 was amended to incorporate the features of claim 14. As amended, the invention defined in claim 13 is directed to a foot structure for a toy that is attached to a lower portion of a shin section of the toy. The structure comprises a foot section and a heel mounting mechanism. The foot section has a tiptoe section and a heel section. The heel mounting mechanism attaches the heel section to the shin section. The heel mounting mechanism is constructed such that the heel section can move with respect to the shin section so that a whole bottom face of the heel section can be in full contact with a setting surface whenever the shin section stands erect or the shin section is inclined in a lateral direction as seen from the tiptoe side. Further, the heel mounting mechanism is constructed such that the heel section can be inclined right and left with respect to the shin section independently from the tiptoe section as the shin section is seen from the tiptoe section.

In addition to incorporating the features of claim 14, the composition of the foot section of claim 13 has also been amended. As amended, the tiptoe section is constituted from one component and the heel section is constituted from another component. Support for this amendment can be found in paragraph [0045] of the specification.

Of particular relevance to the present argument is that the tiptoe section and the heel section are constituted from different components. Further, the heel section

is not restricted by the movement of the tiptoe section and can be inclined to the left and right with respect to the shin independently from the tiptoe section. Accordingly, when the foot section of the toy is opened to the right and left, and the toy is transformed into a certain posture in which the tiptoe section is not in contact with the setting surface, the heel section can be in full contact with the setting surface. Thus, the toy of claim 13 can stand more stably than conventional toys.

In rejecting claim 13, the Examiner cites to Ohno for disclosing a transformable toy that can be transformed from a four-wheel car into a robot. When the toy of Ohno is in robot form, the toy has feet that are formed of a single component. As such, Ohno fails to teach or suggest a transformable toy that has a foot section with a tiptoe section and a heel section, wherein the tiptoe section and heel section are constituted from separate components. Further, Ohno fails to teach a foot section wherein the heel section can be inclined to the left and right with respect to the shin section independent from the tiptoe section. As these features of claim 13 are not taught or suggested by Ohno, they must be disclosed by Lee in order to establish a *prima facie* case of obviousness.

Lee discloses a toy doll. The toy doll of Lee has a tiptoe and a heel section that are constituted from separate components. However, in Lee, the toe members (210, 212) are connected to the foot shells (202) via assembly pins (216) which are disposed at the foot shells (202). Therefore, in contrast to the invention defined in claim 13, the foot shells are restricted by movement of the toe members, and are thereby unable to move independently from the toe members. As such, the foot shells of Lee cannot be inclined right and left with respect to the shin section independently from the toe members. Thus, Lee does not remedy the shortcomings

of Ohno in regards to the heel section being capable of inclining with respect to the shin section independent of the toe members.

Therefore, claim 13 recites features that are not taught or suggested by the combined references. For this reason, a *prima facie* case of obviousness has not been established in support of the rejection of claim 13. Reconsideration and withdrawal of the rejection of claim 13 is requested. Claims 15 – 17 depend from claim 13 and are therefore likewise considered allowable over the art.

Claims 18 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno in view of Lee. The rejections are traversed for the following reasons.

Claim 18 has been amended to include the features of claim 2. As the Examiner indicated that claim 2 included allowable subject matter, the inclusion of said subject matter into claim 18 is considered to make claim 18 allowable. Accordingly, the amendment to claim 18 is considered to circumvent the present rejection. Reconsideration and withdrawal of the rejection of claim 18 is requested. Claim 19 depends from claim 18 and is therefore likewise considered allowable over the art.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. NIS-16758.

Respectfully submitted,

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